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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/643,317

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Terry C. McNally

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EXAMINER

HUANG, SIHONG

ART UNIT

PAPER NUMBER

2632

DATE MAILED: 06/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/643,317	Applicant(s) MCNALLY, TERRY C.	
	Examiner Sihong Huang	Art Unit 2632	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>Nov. 3, 2003</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 10 and 11 are objected to because of the following informalities:

In claim 10, line 2, "aid" should read as --said--.

In claim 11, line 4, "spefing" should read as -- spring --.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

- a. Claim 1 requires "the first contact and second contact plate to contact one another completing an electrical circuit between said power source and said speaker". This limitation implies that the first and second contact plates of the mat form a part of the electrical circuit connecting the power source and the speaker, and which appears that such limitation is directed to the first embodiment as shown in Fig. 12. However, claim 4 which depends on claim 1 requires "a wireless connection... a transmitter... and a receiver .." which appears such limitation is directed to the second embodiment as shown in Fig. 13. As shown in Fig. 13, the contact plates (34, 36) are not part of "an electrical

Art Unit: 2632

circuit” connecting a speaker 26 and the power source. Therefore, it appears that claim 4 recites the combination embodiments of Figs 12 and 13, and the specification fails to adequate for such combination embodiments. Thus, the specification is non-enabling for claim 4.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 11, lines 9-10, “said speaker box” lacks antecedent basis.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 5-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulman et al. (US 5,210,528) in view of Berseth (US 4,194,101).

Schulman et al disclosed a pressure sensitive apparatus comprising: a mat (col. 3, line 60 to col. 4, line 21) having panels (382, 384) with conductive strips (370, 390), a speaker box (Fig. 3) including a speaker (260) and a power source (240) connected to said speaker, and means (col. 3, line 61 to col. 4, lines 21) for connecting said power source (240) to said speaker (260)

Art Unit: 2632

through said mat, wherein upon applying a pre-determined amount of pressure on said mat (e.g. by a person stepping thereon, col. 4, lines 14-15), overcomes a bias force causing said conductive strips ("first and second contact plates") to contact one another completing an electrical circuit between said power source (240) and said speaker (col. 260) and causing an audible sound to be emitted from said speaker (col. 4, lines 14-21).

The only difference between Schulman et al and claim 1 of the present invention is the conductive strips or contact plates are not bias by a spring. However, using a spring for the purpose of biasing is extremely well known in the art. For example, Berseth clearly disclosed that either elastic buffers or spring can be used for biasing (col. 3, lines 7 and 45). As the conductive strips of Schulman et al need a biasing means in order to keep them open, it would have been obvious to a person having ordinary skill in the art at the time of the invention to use such well known biasing spring as taught by Berseth in the apparatus of Schulman et al in order to keep the contact plates or strips when no force is applied on the mat (e.g. when on person steps on the mat).

Regarding claim 2, the mat of Schulman et al includes a first side (382) and a second side (384), said first and second contact plates (370, 390) being positioned between said first and second sides of said mat (Fig. 5).

Regarding claim 3, the connecting means of Schulman et al is a wire (see leads 310, 320, 410, 420 and Fig. 4).

Regarding claim 5, the speaker box of Schulman et al includes a speech module 250 (or tone sequencer) which allows at least 16 speeches for subsequent playback (col. 3, lines 55).

Art Unit: 2632

Regarding claims 6, and 9, the speech module or tone sequencer of Schulman et al includes a memory unit (col. 3, lines 35-36, 40-43 and 55-60), the memory unit is selectively programmable (col. 1, lines 30-35, and col. 2, lines 5-6 and 11-13) to include at least one of pre-stored sounds and user defined sounds (e.g., toggling the record button, four, eight or 16 second speeches may be recorded by the user for subsequent playback (col. 3, lines 40-43).

Regarding claim 7, the speaker box of Schulman et al includes a power switch (col. 3, lines 55-60).

Regarding claim 8, although Schulman et al do not specifically show tone selection buttons, Schulman et al do disclose the speech module may be either programmed with a user-selectable message or may contain a preprogrammed message such as "welcome", "good morning", etc (col. 1, lines 30-36). In addition, examiner takes Office notice that providing a recording unit with such selection buttons is extremely well known (e.g., message forward and backward buttons). Therefore, it would have been obvious to provide such selection buttons with the speech module of Schulman et al in order to allow a user to easily select a desirable recorded message.

Claim 11 is a method claim which corresponds to apparatus claim 1 as discussed above. The claimed exerting step is met when a person stepping on the mat (col. 4, lines 14-15), the claimed signaling step is met when a person stepped on the mat a closing electrical circuit is completed between the speaker, power supply and conductive strips resulting in signaling to a speaker (col. 4, lines 15-21), and the emitting step is met when the speaker emits or generates a sound.

Art Unit: 2632

8. Claims 1-9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulman et al. (US 5,210,528) in view of Grady et al. (US 5,604,478).

Schulman et al disclosed a pressure sensitive apparatus comprising: a mat (col. 3, line 60 to col. 4, line 21) having panels (382, 384) with conductive strips (370, 390), a speaker box (Fig. 3) including a speaker (260) and a power source (240) connected to said speaker, and means (col. 3, line 61 to col. 4, lines 21) for connecting said power source (240) to said speaker (260) through said mat, wherein upon applying a pre-determined amount of pressure on said mat (e.g. by a person stepping thereon, col. 4, lines 14-15), overcomes a bias force causing said conductive strips ("first and second contact plates") to contact one another completing an electrical circuit between said power source (240) and said speaker (col. 260) and causing an audible sound to be emitted from said speaker (col. 4, lines 14-21).

The only difference between Schulman et al and claim 1 of the present invention is the conductive strips or contact plates are not bias by a spring. However, Grady et al, from the same field of endeavor, similarly, teach a pressure sensitive apparatus with springs for biasing (col. 4, lines 55-67). Based on this teaching, it would have been obvious to a person having ordinary skill in the art at the time of the invention to use such well known biasing spring as taught by Grady et al in the apparatus of Schulman et al in order to maintain the contact plates or strips in open condition when no force is applied on the mat (e.g. when on person steps on the mat).

Claims 1-3, 5-9 and 11 are rejected for the same reasons as discussed in paragraph 7 of this Office action.

Regarding claims 4 and 12, Schulman et al further differ from these two claims in that Schulman et al do not shown a wireless connection. However, Grady et al further teach that the

Art Unit: 2632

pressure sensitive apparatus has a wireless transmitter and receiver (Fig. 2) wherein upon a pet applies pressure to the sensing unit, the switch energizes the transmitter (33) to transmit a signal to receiver (22) which in turn activates the chime to produce audible sound by a speaker 26 (col. 5, lines 14-24). Based on this teaching, it would have been obvious to a person having ordinary skill in the art at the time of the invention to incorporate such wireless transmitter and receiver as taught by Grady et al to the apparatus unit of Schulman et al so that the speaker box can be separated from the mat in order to prevent damage and allow portability (col. 1, lines 20-40).

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schulman et al. (US 5,210,528) in view of Grady et al. (US 5,604,478) as applied to claims 1-9, 11 and 12 above, and further in view of Chang et al. (US 2003/0112266 A1).

The combination of Schulman et al and Grady et al differs from claim 10 in that it does not show a display. However, Chang et al teach such (pp0042 and pp 61, lines 14-20). Based on this teaching, it would have been obvious to a person having ordinary skill in the art at the time of the invention to update the recorder of Schulman et al with the record having a display means as taught by Chang et al in order to allow a user to see the recorded message.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sihong Huang whose telephone number is 571-272-2958. The examiner can normally be reached on Mon & Thu.

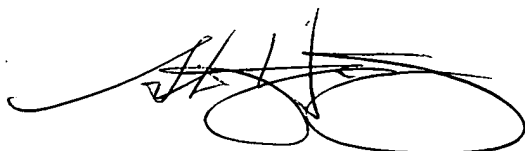
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel J. Wu can be reached on 571-272-2964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Art Unit: 2632

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sihong Huang  
June 6, 2005

A handwritten signature in black ink, consisting of stylized, overlapping loops and lines, positioned to the right of the typed name and date.